



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/467,566	06/06/95	HOFMANN	G

08/467,566 06/06/95 HOFMANN

33M1/1022

FRELING E BAKER
BAKER MAXHAM JESTER & MEADOR
750 B STREET
SUITE 3100
SAN DIEGO CA 92101

EXAMINER

ROCKELMAN M

ART UNIT

PAPER NUMBER

3306

7

DATE MAILED: 10/22/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 7-15-96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1-4, 26 - 46 are pending in the application.

²⁻⁴ Of the above, claims 8, 6, 28, 30-34, 36-39, 42, 43, 45-46 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1, 27, 35, 40-41 and 44 are rejected.

5. Claims 29 are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Part III DETAILED ACTION

Election/Restriction

1. Applicant's election of species II as disclosed in figures 3-6 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)).
2. Claims 2-4, 26, 28, 30- 34, 36-39, 42--43, 45-46 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected species . Election was made **without** traverse in Paper No. 6.

In applicant's response of 7-15-96 applicant alleged that claims 1-30, 35, 36, 39-41 and 44 read upon the elected species with claims 36 and 41 being generic. The examiner disagrees for the following reasons. First claims 5-25 have been cancelled. claims 2-4, 26, 28, 30 and 39 all recite at least one of 1) a cannula 2) delivering drugs or a collar member, or 3) a center placed needle surrounded by a circular array all three limitations being readable on species I and not on elected species II. Claim 36 recites a combination needle electrode which reads only upon non-elected species III. While dependent claims 27, 40 recite limitations pertaining to the elected species, they are improper since they include other structure not disclosed (applicant has mixed embodiments). Nevertheless, these claims

will be retained for prosecution on the merits in hopes applicant cures their dependency in his response. Hence claims 1, 27, 29, 35, 40-41 and 44 will be examined.

Specification

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification as originally filed does not provide support for the invention as now claimed.

Elected species II was not disclosed as having a central electrode, or a collar as claimed in claim 27 through its dependency off claims 2-4 and 26. Similarly, the elected species as originally filed does not teach the use of combination electrodes (species III) with a centrally disposed needle (species I claim 39) and an alternator as required in claim 40 (as a result of its dependency from claim 36 and 39).

Claim Rejections - 35 USC § 112

4. Claims 27 and 40 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Applicant's improper mixing of embodiments due to claim dependency results in new matter in claims 27 and 40.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 41 and 44 are rejected under 35 U.S.C. § 102(b) as being anticipated by Slovak USPN 5,058,605. Slovak teaches a plurality of electrodes (2 and 3) which may have opposite pairs (i.e. electrode 2 paired with each individual electrode one at a time. The examiner gives the functional language little to no patentable weight in regards to the pulse generator since the "electroporation" language is intended use and applicant has not invoked 6th paragraph language.

7. Claims 1, , 35, 40, 41 and 44 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hofmann USPN 5,273,525. Hofmann teaches a pulsing set of electrodes which would switch the electrodes on and off by an on off switch. (claim 40)

Allowable Subject Matter

8. Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent

Serial Number: 08/467,566
Art Unit: 3306

-5-

form including all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Bockelman whose telephone number is (703) 308-2112. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Millin, can be reached at 308-1065. The group facsimile number is (703) 305-3590.

Mark Bockelman

MARK BOCKELMAN
PATENT EXAMINER
GROUP 3300

Mark Bockelman
October 15, 1996